

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claim 1 has been amended to incorporate the basis weight of claim 4.

Claim 4, in turn, has been limited to the thickness previously alternatively recited there.

Claim 7 has been amended to delete the “it being possible” clause.

The “it being possible” clause has been made the subject of new claim 12.

Applicants do not believe that any of these amendments introduce new matter. An early notice to that effect is earnestly solicited.

Claim 7 was rejected under 35 USC § 112, second paragraph, as being indefinite. In response, as noted above, the “it being possible” clause of claim 7 has been canceled and made the subject of new claim 12. Applicants believe this moots this issue.

Claims 1, 2 and 4-11 were rejected under 35 USC § 102(b) as being anticipated by Samson-Himmelstjerna et al. (“Samson-Himmelstjerna”), US 2003/0198806.

Claim 3 was rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over Samson-Himmelstjerna.

In response to *both* rejections of all of the pending claims, Applicants respectfully submit that Samson-Himmelstjerna does not anticipate or render obvious any of the pending claims.

Therefore, Applicants respectfully request that the Examiner reconsider and withdraw both rejections.

As noted above, the basis weight limitation of previous claim 4 has been incorporated into claim 1 and, therefore, all of the other pending claims. Such basis weight limitation requires a basis weight of 40 to 600 g/m². The Examiner finds this limitation anticipated by Samson-Himmelstjerna's teaching of 25 to 80 g/m² in paragraph [0085]. However, the range "25 to 80 g/m²" does not anticipate the range "40 to 600 g/m²". There is overlap, to be sure, but not exact identity, nor is the range "25 to 80 g/m²" fully embraced by the range "40 to 600 g/m²". Accordingly, as a matter of law, the range "25 to 80 g/m²" does not anticipate the range "40 to 600 g/m²". See, for example, *Atofina v. Great Lakes Chemical Corp.*, 78 USPQ2d 1417, 1424 (Fed. Cir. 2006) ("The disclosure is only that of a range, not a specific temperature in that range, and the disclosure of a range is no more a disclosure of the end points of the range than it is of each of the intermediate points.")

In view of the foregoing, Applicants respectfully submit that Samson-Himmelstjerna cannot anticipate any of the rejected claims. An early notice to this effect is earnestly solicited.

On the issue of obviousness, Applicants respectfully submit that Samson-Himmelstjerna fails to make out a *prima facie* case of obviousness and, moreover, even if it did, such is rebutted by the comparison data in the instant specification.

Thus, the Examiner has not pointed to a single specific embodiment falling within the instant claims or anything in Samson-Himmelstjerna that would have motivated persons having ordinary skill in the art to make and use an embodiment falling within the instant claims as

opposed to an embodiment falling outside of the instant claims. Applicants respectfully submit that overlap, in and of itself, is insufficient, as a matter of law, to make out a *prima facie* case of obviousness. *See, for example, In re Baird*, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.”) Instead, a *prima facie* case of obviousness is only made out if the prior art highlighted the selections that must be made to achieve the claimed compounds in some manner, and, therefore, led persons skilled in the art towards them. The Examiner has not pointed to anything in Samson-Himmelstjerna that would have led persons having ordinary skill in the art to make and use an embodiment falling within the present claims as opposed to an embodiment falling outside of the instant claims. In the absence of anything leading persons skilled in the art towards the instant range, Applicants respectfully submit that Samson-Himmelstjerna utterly fails to make out a *prima facie* case of obviousness.

Further, the data in the instant specification establish the criticality of the interlayer C basis weight. The data reported on pages 14 ff, as summarized in Table 2 on page 14, and Table 3 on page 16, show that very high abrasion and scuff resistances are achievable only if the basis weight of interlayer C is manipulated within the presently claimed ranges. Compare A and B to C and D in Table 2; and 3 to 5-9 in Table 3. See also the Counterexample on page 19. There is nothing in Samson-Himmelstjerna establishing the basis weight of interlayer C as a result-effective variable affecting abrasion and scuff resistance. Consequently, a person having ordinary skill in the art would not, as a matter of law, have found it obvious to optimize this parameter. *See, e.g., In re Antoine*, 195 USPQ 6 (CCPA 1977), for the proposition that there is no motivation to optimize a variable where the prior art does not reveal the optimized variable to

be result-effective.

Put another way, there is nothing in Samson-Himmelstjerna that teaches or suggests that manipulating the basis weight of interlayer C within the presently claimed range should have the dramatic improvement shown on abrasion and scuff resistance. Accordingly, the data in the instant specification must be regarded as surprising and unexpected and, therefore, as objective evidence of nonobviousness. Further, although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

In view of the foregoing, Applicants respectfully submit that Samson-Himmelstjerna also cannot render *prima facie* obvious any of the rejected claims. An early notice to this effect is also earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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